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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,014	06/15/2001	Michael Smith	1826 (42059-01360)	9634

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TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 05/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/883,014

Applicant(s)

SMITH, MICHAEL

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 8-11, 14-16 and 18-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-11, 14-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

***Claim Status***

Claims 8-11, 14-16 and 18-20 are pending in this application. Claims 1-7, 12, 13 and 17 have been cancelled. Claims 8-11, 14-16 and 18-20 are rejected in this office action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-11, 14-16 and 18-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 8 recites “searching the shared directory to identify address entries in the shared directory which include the hierarchal information based on a canonical form of an identifier included in each address entry in the shared directory.” The specification does not contain a clear and concise description of the manner and process of searching the shared directory such that a skilled artisan would conclude that at the time the invention was filed that the inventor had possession of the invention. Particularly, the specification makes no reference to (1) a canonical form of an identifier, and (2) an identifier included in an address entry.

Claim 8 recites “presenting to the at least one entity initiating the query only the identified address entries in a second view.” The specification does not contain a clear and concise description of the manner and process of making a second view such that a skilled artisan would be convinced that the inventor had possession of the invention at the time the application was filed. The problem with making a second view is compounded by the lack of a clear description of the process of making a first view to which access is denied.

Claim 15 is rejected for including language similar to claim 8.

Claims 9-11, 14 16 and 18-20 are rejected, at least, for being dependent from a rejected base claim.

Claim 15 recites “each of the address entries including a canonical form of an identifier in a hidden field.” The specification does not contain a clear and concise description of “hidden field” such that a skilled artisan would be convinced that the inventor had possession of the invention at the time the application was filed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-11, 14-16 and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites “presenting to the at least one entity initiating the query only the identified address entries in a second view.” The metes and bounds of the invention cannot be determined because it is unclear what comprises “the identified address entries” per applicant’s most recent claim amendment. Claim 1 recites “detecting [ ..... ] at least one address entry in a shared directory” and furthermore claim 1 claims “a canonical form of an identifier included in each address entry” and furthermore, claim 1 claims “presenting to the user [ ..... ] the identified address entries and furthermore, claim 8 recites “searching the shared directory to identify address entries in the shared directory.” The scope of the invention cannot be determined because it is unclear whether above four (emphasis added) instances of address entries are the same or different address entries.

Claim 15 is rejected for including language similar to claim 8.

Claims 9-11, 14 16 and 18-20 are rejected, at least, for being dependent from a rejected base claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-10, 14, 16, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pub No US 2002/0120716 issued to Raghunathan (hereafter Raghunathan) in view of US

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Pat No 5,930,764 issued to Melchione et al (hereafter Melchione) and further in view of US Pat No 5,878,415 issued to Olds (hereafter Olds).

Claim 8:

Raghunathan discloses as admitted prior art:

detecting a query from at least one entity over a data network seeking a first view of at least one entry in a shared directory [application server 1220, Fig 12, paragraph 13]

retrieving identification information for the at least one entity, wherein the identification information includes hierarchical information associated with the at least one entity [paragraph 17, employees access data depending on their position]

searching the shared directory to identify entries in the shared directory which includes the hierarchical information [paragraph 13, database server 1250 accesses scheduling/accounting/personnel/payroll application data]

presenting to the at least one entity initiating the query only, all of the identified at least one entry in a second view [paragraph 17, employees access data and system resources depending on their position]

Raghunathan discloses the essential elements of the claimed invention as noted above but does not disclose denying access to the first view based on the hierarchical information.

Melchione discloses denying access to the first view based on the hierarchical information [Melchione, access is restricted, col 17, lines 1-5]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Raghunathan to include denying access to the first view based on the hierarchical information as taught by Melchione for

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the purpose of purpose of restricting access to highly confidential and valuable information maintained by financial institutions [Melchione, col 16, lines 65-67].

Raghunathan discloses the essential elements of the claimed invention as noted above but does not disclose an address entry in a shared directory. Olds discloses an address entry in a shared directory [col 1, line 67]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Raghunathan to include an address entry in a shared directory as taught by Olds for the purpose of providing an electronic database of employee information which can be accessed and maintained electronically.

The combination of Raghunathan, Melchione and Olds discloses hierarchal information based on a canonical form of an identifier in each address entry in the shared directory [Olds, col 1, line 67]

Claim 9:

The combination of Raghunathan, Melchione and Olds discloses the elements of claim 8 as noted above and furthermore, discloses wherein the shared directory is configurable for supporting emessaging [Olds, E-mail address, col 1, line 67].

Claim 10:

The combination of Raghunathan, Melchione and Olds discloses the elements of claim 8 as noted above and furthermore, discloses wherein the entities comprise at least one of at least one person and at least one group [Olds, network user, col 1, lines 23-35]

Claim 14 and 19:

The combination of Raghunathan, Melchione and Olds discloses the elements of claims 8/15/16 as noted above and furthermore, discloses wherein the first view is a listing of all entries

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in the directory and the second view is a copy of the listing with modified selection criteria [Olds, administrator is able to make global changes thus has global access, col 3, lines 55-65, user is granted access per the access control list 74, Fig 4, col 8, line 61 – col 9, line 2].

Claim 16:

The combination of Raghunathan, Melchione and Olds discloses the elements of claim 15 as noted above and furthermore, discloses wherein the data network is the internet and the server is configured to communicate with web browsers [Olds, col 6, lines 3-12]

Claim 18:

The combination of Raghunathan, Melchione and Olds discloses the elements of claim 15 as noted above and furthermore, discloses Olds discloses wherein the server and directory are configured to provide hosted emessaging services for a plurality of third parties [Olds, Fig 1, 20,col 6, line 44 – 58]

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olds in view of Pub No US 2002/0104018 issued to Singhani et al (hereafter Singhani).

Claims 11 and 20:



The combination of Raghunathan, Melchione and Olds discloses the elements of claim 8/15 as noted above but does not disclose wherein the hierarchal information includes at least one of company name and company location. Singhani discloses wherein the hierarchal information includes at least one of company name and company location [paragraph 57]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above combination of references to include wherein the hierarchal information includes at least one of company name and company location as taught by Singhani for the purpose of providing necessary information for the purposes of approving/rejecting by an application administrator a request by a user for access to an application [paragraph 57].

Claims 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Raghunathan, Melchione and Olds and further in view of Pub No US 2002/0083123 issued to Freedman et al (hereafter Freedman).

Claim 15:

Raghunathan discloses:

a network server configured for receiving and processing queries from one or more entities of a plurality of entities for accessing directory information over at least one data network and performing functions with regards to accessing associated directories [Raghunathan, Fig 12, paragraph 13]

a shared directory in communication with the server which includes a plurality of address entries, the identifier being associated with at least one entity of the plurality of entities having

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access to the shared directory [Raghunathan, paragraph 13, database server 1250 accesses scheduling/accounting/personnel/payroll application data]

Raghunathan discloses the elements of the claimed invention as noted above but does not disclose wherein the network server is further configured to search the directory and based on the queries, generate a first and at least one additional view of the address entries, wherein access to the first view is restricted and that at least one additional view is a subset of the first view and wherein the at least one additional view provides access to only those address entries in the first view for which the identifier matches identification information for the one or more entities making inquiries. Melchione discloses wherein the network server is further configured to search the directory and based on the queries, generate a first and at least one additional view of the address entries, wherein access to the first view is restricted and that at least one additional view is a subset of the first view and wherein the at least one additional view provides access to only those address entries in the first view for which the identifier matches identification information for the one or more entities making inquiries [Melchione col 17, lines 1-5]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Raghunathan per the above for the purpose of restricting access to highly confidential and valuable information maintained by financial institutions [Melchione, col 16, lines 65-67].

The combination of Raghunathan and Melchione discloses the elements of the claimed invention as noted above but does not disclose a shared directory. Olds discloses a shared directory [colo 1, line 67]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Raghunathan and Melchione per the

above for the purpose of providing an electronic dataset of employee information which can be accessed and maintained electronically

The combination of Raghunathan, Melchione and Olds discloses the elements of the claimed invention as noted above but does not disclose each of the address entries including a canonical form of an identifier in a hidden field. Freedman discloses each of the address entries including a canonical form of an identifier in a hidden field [paragraph 27]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Raghunathan, Melchione and Olds to include the above limitation for the purpose of receiving customer data.

### ***Response to Arguments***

Applicant's arguments filed 3/1/2006 have been fully considered but are not persuasive for the following reasons.

#### **Applicant Argues:**

Applicant states that the prior art of record does not disclose the claimed limitations.

#### **Examiner Responds:**

Examiner is not persuaded. The claim limitations are mapped to the prior art as best examiner is able to understand the present invention. Furthermore, examiner notes Rule 37CFR 1.111(b) requires Applicant to "distinctly and specifically point out errors" in the examiner's action. Also, arguments or conclusions of Applicant cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326F.2d 769, 140 USPQ 230 (1964).

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday – Friday between 8:00 am and 4:30 pm.

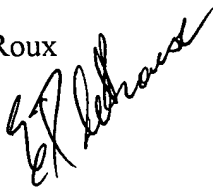
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

5/4/2006

A handwritten signature in black ink, appearing to read 'Etienne LeRoux', is written over the printed name and date.